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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,299	05/31/2006	Kazutoshi Watanabe	P28460	1935
7055 7590 04/03/2008 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
EXAMINER BALASUBRAMANIAN, VENKATARAMAN				
ART UNIT		PAPER NUMBER		
1624				
NOTIFICATION DATE		DELIVERY MODE		
04/03/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com

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### Office Action Summary

**Application No.**

10/550,299

**Applicant(s)**

WATANABE ET AL.

**Examiner**/Venkataraman  
Balasubramanian/**Art Unit**

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 December 2007.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 13, 14 and 16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 1-11 and 13 is/are allowed.  
6) ☒ Claim(s) 14 and 16 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicants' response, which included amendment to claim 1, filed on is made of record. Claims 1-11, 13, 14 and 16 are pending. In view of applicants' response, all 112 rejections, prior art rejections and obviousness-type double patenting rejections made in the previous office action have been obviated,. However, upon further consideration, the following new ground of rejection is applied to claims 14 and 16.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 14 and 16 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for Alzheimer's disease and non-insulin dependent diabetes, does not reasonably provide enablement for any or all neurodegenerative diseases embraced in these claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The instant method of use claims 14 is drawn to a method of therapeutic treatment of Alzheimer disease, ischemic cerebrovascular accidents, Down syndrome, cerebral bleeding due to cerebral amyloid angiopathy, progressive supranuclear palsy, subacute sclerosing panencephalitic parkinsonism, postencephalitic parkinsonism, pugilistic encephalitis, Guam parkinsonism-dementia complex, Lewy body disease, Pick's disease, corticobasal degeneration, frontotemporal dementia, vascular dementia,

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traumatic injuries, brain and spinal cord trauma, peripheral neuropathies, retinopathies, and glaucoma, while claim 16 is drawn to a method for therapeutic treatment of a disease selected from non-insulin dependent diabetes, obesity, manic depressive illness, schizophrenia, and alopecia, comprising administering to a patient a therapeutically effective amount of the composition according to claim 11.

Instant claims 14 and 16, as recited, is a reach through claim. A reach through claim is a claim drawn to a mechanistic, receptor binding or enzymatic functionality in general format and thereby reach through a scope of invention for which they lack adequate written description and enabling disclosure in the specification.

In the instant case, based on the inhibition of TPK1 by the instant compounds, claims 14 and 16 reach through treating various neurodegenerative diseases mentioned above and thereby they lack adequate written description and enabling disclosure in the specification.

More specifically, in the instant case, based on the mode of action of instant compounds as inhibitor of kinase, based on limited assay with limited enzyme, it is claimed that treating and or preventing any or all cancer, infections, inflammatory and autoimmune diseases in general. The scope of the claims includes not only any or all disorders but also those condition yet to be discovered as mediated by TPK1 for which there is no enabling disclosure. In addition, the scope of these claims includes treatment of various diseases, which is not adequately enabled solely based on the inhibition of TPK1kinase provided in the specification .

Applicants have not provided any competent evidence that the instantly disclosed tests are highly predictive for all the uses disclosed and embraced by the claim language for the intended host.

The scope of the claims involves millions of compounds of claim 1 as well as the various neurodegenerative diseases.

As seen, instant compounds can be used for treating any disease which is a remarkable finding for which there is no adequate support in the specification.

No compound has ever been found to treat diseases of all types generally. Since this assertion is contrary to what is known in medicine, proof must be provided that this revolutionary assertion has merits. The existence of such a "compound" is contrary to our present understanding of modern medicine. Further, neurodegenerative diseases covers diverse disorders such as Alzheimer's disease, dementia, hereditary cerebellar ataxias, paraplegias, syringomyelia, phakomatoses, and much more. In fact, Layzer, Cecil Textbook of Medicine (article enclosed), states that "some degenerative diseases are difficult to classify because they involve multiple anatomic locations" (see page 2050). For example, Alzheimer's disease has traditionally been very difficult or impossible to prevent or even to treat effectively with chemotherapeutic agents. See e.g., the Cecil Textbook of Medicine, 20th edition, Vol. 2, wherein it is stated that "[t]here is no cure for Alzheimer's disease, and no drug tried so far can alter the progress of the disease" (pg. 1994). It is known that antipsychotic medications are used to reduce the psychotic symptoms of schizophrenia. The state of the art of such antipsychotic drugs,

however, indicates that 'they do not cure or restrain the symptoms of schizophrenia or ensure that there will be no further psychotic episodes'.

The online information about the treatment options of the disease <http://www.psychologinfo.com/schizophrenia/medication-treatment.html> indicates that 'it is difficult to predict which patients will benefit from treatment with antipsychotic drugs. Different patients have different treatment responses and side effects to various antipsychotic drugs', thus, clearly indicating the unpredictability in the dosage regimen.

Note substantiation of utility and its scope is required when utility is "speculative", "sufficiently unusual" or not provided. See *Ex parte Jovanovics*, 211 USPQ 907, 909; *In re Langer* 183 USPQ 288. Also note *Hoffman v. Klaus* 9 USPQ 2d 1657 and *Ex parte Powers* 220 USPQ 925 regarding type of testing needed to support *in vivo* uses.

Next, applicant's attention is drawn to the Revised Utility and Written Description Guidelines, at 66 FR 1092-1099, 2001 wherein it is emphasized that 'a claimed invention must have a specific and substantial utility'. The disclosure in the instant case is not sufficient to enable the instantly claimed method treating solely based on the inhibitory activity disclosed for the compounds. The state of the art is indicative of the requirement for undue experimentation. See two Cecil references cited above. See also Julien et al., *Prog Nucleic Acid Res Mol Biol.* 61: 1-23, 1998 (PubMed Abstract). All these references suggest the art is still exploratory and that a single agent may not be able to all neurodegenerative diseases. In evaluating the enablement question, several factors are to be considered. Note *In re Wands*, 8 USPQ2d 1400 and *Ex parte Forman*, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the

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prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

1) The nature of the invention: Therapeutic use of the compounds in treating various neurodegenerative diseases that require TPK1 inhibitory activity.

2) The state of the prior art: Recent publications expressed that the kinase effects are unpredictable and are still exploratory. See Two Cecil references and Julien et al., cited above.

3) The predictability or lack thereof in the art: Applicants have not provided any competent evidence or disclosed tests that are highly predictive for the pharmaceutical use for treating various neurodegenerative diseases with the instant compounds. Pharmacological activity in general is a very unpredictable area. Note that in cases involving physiological activity such as the instant case, "the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved". See *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

4) The amount of direction or guidance present and 5) the presence or absence of working examples: Specification has no working examples to show treating neurodegenerative diseases and the state of the art is that the effects of kinase inhibitors are unpredictable.

6) The breadth of the claims: The instant claims embrace various neurodegenerative diseases and huge genus of compounds.

7) The quantity of experimentation needed would be an undue burden to one skilled in the pharmaceutical arts since there is inadequate guidance given to the skilled artisan, regarding the pharmaceutical use, for the reasons stated above.

Thus, factors such as "sufficient working examples", "the level of skill in the art" and "predictability", etc. have been demonstrated to be sufficiently lacking in the instant case for the instant method claims. In view of the breadth of the claims, the chemical nature of the invention, the unpredictability of enzyme-inhibitor interactions in general, and the lack of working examples regarding the activity of the claimed compounds towards treating and or preventing the variety of diseases of the instant claims, one having ordinary skill in the art would have to undergo an undue amount of experimentation to use the instantly claimed invention commensurate in scope with the claims.

MPEP §2164.01(a) states, "A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. In re Wright, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993)." That conclusion is clearly justified here and undue experimentation will be required to practice Applicants' invention.

***Allowable Subject Matter***

Claims 1-11 and 13 are allowed.



### **Conclusion**

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

/Venkataraman Balasubramanian/  
Primary Examiner, Art Unit 1624

